

REMARKS

1. Upon entry of the present Amendment, Claims 1-21 are present in the case. In view of the present remarks, applicants request entry of the present response, reconsideration and withdrawal of the rejections and objections of the pending office action, and allowance of all claims present in the case at an early date.
2. The rejections and objections of the office action of August 15, 2003 have been withdrawn in view of the arguments of the response of October 14, 2003. A new rejection and new objections are imposed by the pending office action, based on newly cited United States Patent No. 4,110,036 to Guillaume.
3. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by Guillaume.
4. Claims 12-15, depending directly or indirectly from Claim 11, are objected to as being dependent upon a rejected base claim, but are indicated as being allowable if rewritten in independent form.
5. Claims 1-10 and 16-21 are declared as allowed. Comments on the reasons recited in the office action for the indication of the allowed status of these claims are given below in a separate section headed: "Comments on Statement of Reasons for Allowance."
6. As a prelude to answering the rejection of Claim 11, applicants note the following statement at the top of page 2 of the office action: "Applicant's [sic] arguments with respect to claim 11 have been considered but are moot in view of the new ground(s) of rejection." The office action does not contain a new ground of rejection of Claim 11 because Claim 11 has not been rejected before; it has been declared as allowed by all preceding office actions. Hence, no arguments have been previously submitted in response to rejections of Claim 11 to have been considered but now found moot.
7. In order for a reference to anticipate a claim under 35 USC 102 the claim must read on a disclosure contained in the reference, that is, the disclosure in the reference must contain all of the elements of the claim arranged as in the claim so as to actually disclose the invention as claimed. The '036 patent fails to meet this criterion, and so fails to anticipate the invention of Claim 11.
8. At the outset, Claim 11 is directed to a "contour light projector" and the '036 patent is not. Instead, the '036 patent is directed to apparatus for "making selected color-component records of color transparencies for use in color printing" as recited in the opening of the Abstract of the '036 patent and in the preamble of each of its independent Claims 1, 2 and 20. While these portions of the text may not, of themselves, be completely dispositive of the issue, they do alert the reader

as to the subject matter covered in the text and illustrations. No effort is made in the office action to conclude that the '036 patent does indeed disclose an actual "contour light projector" as recited in the rejected Claim 11.

9. Moving on, the office action alleges that "a housing assembly" as claimed is found at 36 in the '036 patent. This is incorrect. Item 36 is the upper "wall" of the chassis 1 as recited at column 4, lines 1-3, and as indicated in Fig. 4. The office action alleges that the claimed "condensing lens" is found at 10 in the '036 patent, but 10 is identified as "an optical condenser 10 having a lens system and a rear light shield 11 in the form of a box which is connected to the light-generator chassis 1 by a bellows 12" (column 2, lines 33-36). The office action also finds "the condensing lens" at 17. However, 17 is a "support" as discussed at column 2, lines 43-50. The office action identifies an "elongated base (2,3)" as the optical bench. In the '036 patent one finds the "chassis 1 arranged to slide on two parallel horizontal guide rails 2, 3 forming an optical bench and united by a chassis 4 of an optical condenser and by an end cross-piece 5" (column 2, lines 26-33). However, this optical bench is external to the chassis 1, which the office action apparently means to rely on as the claimed housing assembly. The chassis 1 is made to slide on the guides 2, 3 as noted, and does not have the guides mounted within. However, the claim specifically recites "an optical bench mounted within the housing." Consequently, the '036 patent does not disclose the optical bench and housing assembly as claimed.

10. Finally, the office action looks to the discussion appearing at column 2, lines 64-67 and column 3, line 1 to provide disclosure of the claimed "light beam contour mask." While the word "masks" appears at the end, that discussion has nothing to do with a "light beam contour mask." Again, the opening sentence of the text at column 1, lines 5-9 provides a clue: "The invention concerns a unit for reproducing transparent originals, notably for making colour selections, comprising a light generator producing a beam of light directed via a light condenser to a camera, and a carrier for supporting an original in said light beam." The apparatus produces a light beam directed into a camera, and the camera 22 is what is under discussion at column 2, line 47 to column 3, line 1. The camera 22 has an objective 21 which is connected to the body of the camera by a bellows 25, and the body of the camera 22 and the objective 21 may move relative to each other. Further, the discussion at that point (column 2, lines 55-57 and beyond) in the '036 patent directs the reader to Swiss Patent No. 575,610 and corresponding U.S. Patent No. 3,984,849, naming the same inventor Guillaume as inventor, for details. While the '036 patent does not mention or illustrate a "light beam contour mask" the office action may be implying that disclosure of the missing claim element may be found in the referenced Swiss or U.S. patents. However, the office

action does expressly cite either the referenced Swiss or U.S. patent. Therefore, enclosed herewith is a Third Information Disclosure Statement with attached Form PTO-1449 presenting for citation the referenced U.S. Patent No. 3,984,849, along with a copy of that patent, identifying that patent as reference A10 submitted by the applicants.

11. The '849 patent, reference A10, relates to apparatus for photographically producing color separations on black-and-white film from a color transparency, for example. See the discussions at column 2, lines 52-57, column 3, lines 3-5, and column 15, lines 10-25 for how the apparatus may be used. For the embodiment of Figs. 1-6 the mask is shown in Fig. 1 at 24 and its nature and placement in the apparatus are described at column 4, lines 17-46. The mask 24 is a film mask, made with photosensitive material. After exposure in the camera 5, the mask 24 is removed and developed, then replaced into the camera where the "mask serves to correct the variations in the absorption of various wavelengths by black-and-white films (masking operating)" (column 4, lines 34-36). No mask is illustrated for the embodiment of Figs. 7-11, but in this connection production and use of masks, including a negative mask, are discussed, for example, at column 11, lines 23-47, column 14, lines 26-33, and column 14, lines 54-61. The masks of reference A10 are not, however, light beam contour masks. Thus, the masks mentioned in the '036 patent as referenced by the office action are likewise not light beam contour masks. Finally, again, the apparatus of the '036 patent is not a contour light projector.

12. In view of the fact that the '036 patent does not disclose apparatus that contains all of the elements of the invention as defined by Claim 11, even with added consideration of the '849 patent, the '036 patent does not anticipate Claim 11, and the rejection of Claim 11 under 35 USC 102(b) should be withdrawn. Likewise, since Claims 12-15 depend from an allowable claim, the objections to Claims 12-15 should be withdrawn.

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

a. 37 CFR 1.104(e) states, in part: "*If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning.*" (Emphasis added) The rule is thus permissive, providing the examiner believes that the prosecution record, as a whole, does not make clear the reasons for allowing claims. Otherwise, there does not appear to be any justification for making such a statement.

b. 1302.14 MPEP states, in part: "Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record."

c. On the basis of these two statements, the presence of a statement of reasons for allowance (A) would mean that the examiner believes that the reasons for allowance of claims is either missing from or not clear in the record as a whole, and (B) would require identification of the major differences between each allowed claim and the prior art along with the reasons why those differences determine that the claims are allowable, whatever is not clear in the record.

d. The statement of reasons for the indication of allowable subject matter in the present office action is a continuous recitation of parts of unidentified claims with the assertion that the prior art does not disclose that recitation. There is no suggestion that the record is inadequate to discern the reasons for allowance in order to justify a statement of those reasons. There is no separate comparison of each allowable claim to the prior art with a specific reason as to why the difference(s) between each claim and the prior art is considered to define the claim as patentable. Is the statement meant to be complete and comprehensive, or just to fill in any gaps the examiner may feel are present in the reasoning appearing in the record? Why is the statement included at all? In short, how is the statement clarifying anything?

e. Applicants believe that the record as a whole does make clear the reasons for allowance of all of the claims and that therefore no statement of reasons for allowance is justified. To the extent that the statement of reasons for allowance might place unwarranted narrowing interpretations on the claims and/or establish estoppel effects, applicants do not acquiesce in the present statement of reasons for allowance or any other statements of reasons for allowance, either already in the record or that might be entered at a later date.

CONCLUSION

Based on the foregoing analysis applicants respectfully assert that all Claims 1-21 are in condition for allowance. Therefore, applicants earnestly request withdrawal of all rejections and objections, and allowance of all Claims 1-21 at an early date. If anything further is required to place the entire application in condition for allowance, the examiner is respectfully requested to telephone the undersigned representative.

Respectfully submitted,

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